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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/766,298	01/19/2001	Keirou Shinkawa	16869N020600	9630
20350	7590	02/03/2006		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER RAMAN, USHA	
			ART UNIT	PAPER NUMBER
			2617	

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/766,298

Applicant(s)

SHINKAWA ET AL.

Examiner

Usha Raman

Art Unit

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 20-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                                              |                                                                                         |
|----------------------------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                                             | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                                          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>1-17-06</u> . | 6) <input type="checkbox"/> Other: _____                                                |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 17<sup>th</sup>, 2005 has been entered.

***Response to Arguments***

2. Applicant's arguments filed October 17<sup>th</sup>, 2005 have been fully considered but they are not persuasive.

Applicant argues that, "Ellis does not disclose or teach the viewer related features originating from the broadcast stations". However, this feature is not recited in the claims.

Applicant also argues that, "Ellis is completely absent to any reference to a 'connection to enable retrieval of data from data broadcasting service of each broadcast station' ". The examiner respectfully disagrees. Ellis teaches obtaining data (including program guide data; see [0037]) from various data sources 14 over link 41 (see [0038]), as well as querying the various sources for user requested data and obtaining (i.e. retrieval) data from the various sources in response to user query (see [0084]). As a result, the examiner maintains rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 20-27 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 20 recites the limitation, "a second receiver for receiving the unique information transmitted by the plurality of broadcast stations....the unique information comprising electronic program guide (EPG) data for the plurality of broadcast stations, content data for various broadcast suppliers and **user search history**". However applicant's disclosure states that a user search history is maintained by the search system, wherein the user search history is transmitted by the search system to the broadcast suppliers, and not the other way around. See disclosure page 11, lines 5-8 and page 12, lines 7-14.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 20-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Ellis et al. (US Pre Grant Pub. 2003/0020744).

In regards to claim 20, Ellis discloses a search system comprising:

A plurality of broadcast stations (i.e. a plurality of data sources 14 providing program guide data; see [0037]), each for configured to transmit unique information (program guide data and video content programming) related to contents of a program through a channel associated with the broadcast station (see figure 1, [0006], [0037]);

A first receiver (22) for receiving the unique information related to the contents of the program transmitted through a predetermined channel (see [0043]), the receiver coupled to a search requesting device (input device, 40, used to make search request) for sending a search request of the unique information transmitted through a channel (uplink channel) other than the predetermined channel (see [0046]-[0047]); and

A search system including

A second receiver receiving the unique information transmitted by the plurality of broadcast stations through the respective channels and storing such unique information in a storage device (56); see [0039], [0044], [0045]; the unique information comprising electronic program guide data for the plurality of broadcast stations content data for various broadcast suppliers and user search history (see [0037])

A connection (link 41) to enable retrieval of data from a data broadcasting service of each broadcasting station (data sources located at plurality of facilities provide data to main facility 12 over link 41, which further provides data to program guide equipment 17; see [0038], [0040] and [0084])

A searching device (54) coupled to the storage device (56) for searching the storage device and the data from the data broadcasting service (other program guide data sources) in response to receipt of a search request; see [0046] and [0084].

A transmitter for transmitting information to the first receiver in response to the search request, such information including information from the data broadcasting service (i.e. comprises circuitry for transmitting information to user equipments over communications network. See [0046], [0084]);

Wherein the search system is configured to provide service guide information of the data broadcasting service of each broadcasting station (search system obtains information from program guide data sources, and provide them to program guide client; see [0084]).

In regards to claim 21, Ellis discloses that the first receiver displays a search screen information transmitted by the second transmitter to thereby facilitate search requests for the first receiver. See figures 9a, 9b and [0078].

In regards to claim 22, Ellis discloses the first receiver includes storage for storing a history of unique information received and a system for transferring that history upon request (i.e. periodic polling by the server). See [0107], [0108], [0125].

In regards to claim 23, Ellis discloses that the unique information includes program guide information about contents of the programs. See [0039].

In regards to claim 24, Ellis discloses that the request from the search requesting device and the transmission of the second transmitter are conducted through a telephone line (i.e. user equipment comprises modem to connect to the program guide server over the Internet). See [0046], [0047], [0051], [0058].

In regards to claim 25, Ellis discloses that the request from the search requesting device and the transmission of the second transmitter are conducted through a communication network. See [0046], [0047].

In regards to claim 26, Ellis' system comprises an accounting system for collecting charge information payable based upon the searching requested (i.e. a search query can be for a pay per view programming, therefore in order for a user to view the pay per view program, a payment must be collected from the user). See [0107].

In regards to claim 27, Ellis' system further comprises a trend information collecting system for collecting viewer trend information based upon the search requests (i.e. viewer history is collected to make future recommendations, therefore viewer trend is analyzed for making such recommendations). See [0010], [0111],

In regards to claim 28, Ellis discloses a search system comprising:  
A plurality of transmitting apparatuses (12), each having a transmitter for transmitting unique information (program guide data) in relation to contents of a program through a channel for exclusive use thereof (see figure 1, [0006], [0037]),

A receiving apparatus including a first receiver (22) for receiving the unique information dependent upon contents of the programs transmitted, and a search requesting device (user input device 40) for requesting a search on the unique information transmitted through a channel other than that predetermined channel (see [0046], [0047]); and

A search apparatus including

A second receiver for receiving the unique information (17);

A storage (56) for storing all station electronic program guide information of the programs and channels and for storing service guide information about data broadcasting services for the channels; see [0039], [0044], [0045].

A connection to enable retrieval of information of data from a data broadcasting service of each channel (program guide server communicates with the plurality of program guide data sources 14 for retrieval of information; see [0038], [0040] and [0084]);

A searching system (54) for searching the storage upon receiving a request for a search from the receiving apparatus, and a sending device for sending the content retrieved in response to the search request, such content including information from the data broadcasting service. See [0046], [0084].

Wherein the search system is configured to provide service guide information of the data broadcasting service of each channel (search system obtains information from program guide data sources, and provide them to program guide client; see [0084]).



In regards to claim 29, Ellis discloses a search apparatus (17) for receiving transmissions from a plurality of transmitters (12), each transmitting unique information about contents of a program through a channel associated with that transmitter, and for accepting a search request from a receiving apparatus (see [0046]) comprising:

A receiver (17) for receiving the unique information about the contents of the programs transmitted through the channels;

Storage (56) for storing electronic program guide information and service guide information of all of the plurality of transmitters, see [0039], [0044], [0045];

A connection to enable retrieval of information from a data broadcasting service of each channel (program guide server communicates with the plurality of program guide data sources 14 for retrieval of information; see [0038], [0040] and [0084]);

A search system (54) for searching the unique information stored in the storage receipt of a search request (see [0046] and [0084]); and

A transmitter for transmitting content retrieved in response to the search request to the receiving apparatus, such content including information from the data broadcasting service (i.e. comprises circuitry for transmitting information to user equipments over communications network. See [0046], [0084]).

Wherein the search apparatus is configured to provide service guide information of the data broadcasting service of each channel (search system obtains

information from program guide data sources, and provide them to program guide client; see [0084]).

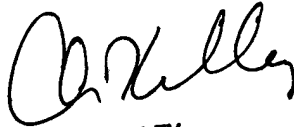
***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Usha Raman whose telephone number is (571) 272-7380. The examiner can normally be reached on Mon-Fri: 9am-6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on (571) 272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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